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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,713	09/26/2001	Rabindranath Dutta	AUS920010539	9285
7590	06/27/2006		EXAMINER	
Darcell Walker 8107 Carvel Lane Houston, TX 77036			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/963,713	<b>Applicant(s)</b> DUTTA ET AL.	
	<b>Examiner</b> Janice A. Mooneyham	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 4-19, 26 and 28-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-19, 26, and 28-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on April 14, 2006, wherein:

Claims 1, 4-19, 26, and 28-43 are currently pending;

Claims 1, 6, 8, 9, 11, 26, 30 and 35 have been amended;

Claims 2-3, 21-25 and 27 have been cancelled.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-19, 26, and 28-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Lederer et al (US 2002/0023109) (hereinafter referred to as Lederer).

Referring to Claims 1 and 26:

Lederer discloses a method and program for maintaining, retrieving, and evaluating information related to a potential business transaction between parties in different jurisdictions using electronic versions of rules from such jurisdictions that apply to the transaction comprising the steps of:

registering for access to the electronic versions of rules from jurisdictions and the search and retrieve mechanisms that will respond to a submitted query [0046-0047], [0072];

submitting a query via a user interface to a database that stores the electronic versions of the rules, the query containing information about the type of transaction, the product involved in the transaction and the jurisdictions involved in the transaction [0013], [0040], [0070], [0100]and [0104];

retrieving, via a server in communication with the database, jurisdictional rules from the database that are related to the specified product, transaction type and jurisdiction [0040] and [0042];

formulating a response based on the retrieved information containing general and specific jurisdictional rules that apply to the transaction and specific requirements for the transaction, said formulated response further containing a profile of the potential transaction described in the submitted query, the profile including information on product type restrictions, product tariffs and product quantity limits [0039], [0040] [0042], [0043] [0049] and [0058-0060]; and

sending the response to the entity submitting the query [0055].

Referring to Claims 4 and 28:

Lederer discloses after the response sending step, the step of retrieving the formulated query response at the customer location [0040] and [0055], [0077];

evaluating the query response [0055];

determining whether the query response is satisfactory to the customer [0055] ;  
and

resubmitting the reformulated query to a database that stores the electronic versions of the rules, the query containing information about the type of transaction, the product involved in the transaction and the jurisdiction involved in the transaction [0079], [0092] [0095].

Referring to Claims 5 and 29:

Lederer discloses after the response sending step, the step of retrieving the formulated query response at the customer location [0055];

evaluating the query response [0055];

determining whether the query response is satisfactory to the customer [0055];

and

when a new query is desired, submitting a new query to a database that stores the electronic version of the rules [0100].

Referring to Claims 6 and 30:

Lederer discloses the step of establishing a connection between a customer and the server and associated database containing the electronic version of the rules, regulations and laws from the jurisdiction [0013].

Referring to Claims 7 and 31:

Lederer discloses the step of determining whether a customer is registered to access the server and database and accepting customer submitted query when the customer is registered to access the server and database [0046], [0072].

Referring to Claims 8 and 32:

Lederer discloses processing the submitted query and identifying the specific request in the query [0040] [0071-0072];

determining whether the query contains sufficient information to enable the generation of a response to the query [0053]; and

sending the request for more information to the customer, if the determination is that there is not enough information to respond to the request in the query [0100].

Referring to Claims 9-10 and 33-34:

Lederer discloses processing the submitted query and identifying the specific request in the query [0040] [0071-0072];

determining whether the query contains sufficient information to enable the generation of a response to the query [0053]; and

generating a response based on the retrieved information, said response containing general and specific jurisdictional rules that apply to the transaction and specific requirements for the transaction [0054];

retrieving the formulated query response at the customer location [0055];

evaluating the query response [0055];

determining whether the query response is satisfactory to the customer [0090];

and

when the determination of the response is not satisfactory and a new query is desired, reformulating the original query [[0092-0095],

resubmitting a new query/ reformulated query to a database that stores the electronic versions of the rules, the query containing the necessary information [0013].

Referring to Claims 11 and 35:

Lederer discloses a method for evaluating a potential business transaction between parties in different jurisdictions using electronic versions of rules from such jurisdictions that apply to the potential transaction comprising the steps of:

retrieving a submitted query, the query containing information about the type of transaction, the product involved in the transaction and the jurisdiction involved in the transaction [0013];

identifying transaction type, product type and jurisdiction information contained in the query [0072], [0077];

retrieving information from a database that stores the electronic versions of the rules [0013] [0040];

generating a profile of a potential business transaction based on the information and the rules retrieved from the database that apply to the potential transaction [0058-0060]; and

sending the transaction profile to the entity submitting the query [0058-0060].

Referring to Claims 12 and 36:

Lederer discloses storing the transaction profile in a section of the database [0058-0060], [0064], [0072].

Referring to Claims 13 and 37:

Lederer discloses the stored transaction profile is arranged in the database according to the jurisdiction and product type [0064].

Referring to Claims 14 and 38:

Lederer discloses generating a general transaction profile for a particular country and product, the general transaction profile being stored in the database and retrieved when a query contains the jurisdiction and product type listed in the profile [0042], [0064].

Referring to Claims 15 and 39:

Lederer discloses the general profile generation step comprising submitting transaction data to a profile generating mechanism, the data comprising a product, a product quantity for the transaction, an export jurisdiction and an import jurisdiction [0042-0043], [0053-0054].

Referring to Claim 16:

Lederer discloses the submitted data is from transaction profiles stored in the database [0049], [0059], [0072].

Referring to Claim 17:

Lederer discloses wherein the submitted data is arbitrarily generated in the database [0049], [0059].

Referring to Claims 18 and 40:

Lederer discloses the step of retrieving a transaction profile comprises identifying the product involved in the transaction [0064],[0072];

identify the export and import jurisdiction [0038], [0042], [0053-0054];



searching the database for a profile having the identified product and  
import/export jurisdiction [0064], [0072] and ; and

returning a profile transaction profile that matches the identified product,  
jurisdiction [0053-0055], [0071-0072].

Referring to Claims 19 and 41:

Lederer discloses the step of retrieving a transaction profile comprises the steps  
of:

identifying the product involved [0013], [0040], [0054];

identifying the jurisdiction [0054];

searching the database for a profile having the identified information [0053-0054];

generating a transaction profile [0055], [0058-0060].

Referring to Claims 42-43:

Lederer discloses wherein the connection and communication occurs over a  
wireless communication network [0061].

### ***Response to Arguments***

Applicant's arguments filed April 14, 2006 have been fully considered but they are not persuasive.

The applicant argues that Lederer fails to disclose the element of a transaction response containing a profile of the potential transaction described in the submitted query, said profile including information about product type restrictions, product tariffs and product quantity limits.

The Examiner disagrees with this assertion. First of all, applicant admits in the Remarks, on page 14, that the description of Lederer does discuss a profile of a potential transaction. Applicant then states that Lederer has language describing some consumer-related information but not about the types of potential transactions or information about tariffs.

The Examiner directs the applicant to paragraph [0040], wherein Lederer discloses that the GRSC 110 consults its internal databases and tables and formulates compliance related data pertaining to the shipment for dispatch to interested parties. The compliance related data may identify procedures that should be followed to ensure the legality of the shipment.

Furthermore, the Examiner asserts Lederer discloses a profile, as admitted by applicant, and a response. Lederer discloses wherein the GRCS summarizes its analysis in one or more reports and forwards its reports to the appropriate parties [0055]. Lederer further discloses that the report may warn the appropriate parties that the receiving region does not allow the ordered product into its jurisdiction or the report may

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identify the requirements and procedures adopted by the affected regions regarding the shipment of the ordered products [0055]. Thus, the Examiner asserts that Lederer discloses a response profile including information on product type restrictions and product limits. Lederer does not explicitly disclose the report disclosing information about tariffs. However, a tariff could fail under the requirements and procedures adopted by the affected region regarding the shipment of the ordered product.

Moreover, the information contained in the response profile is non-functional descriptive data, not structurally related to the steps of the method. The steps of the method would be performed the same no matter what data is contained in the response profile. The data does not modify the steps of the method. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

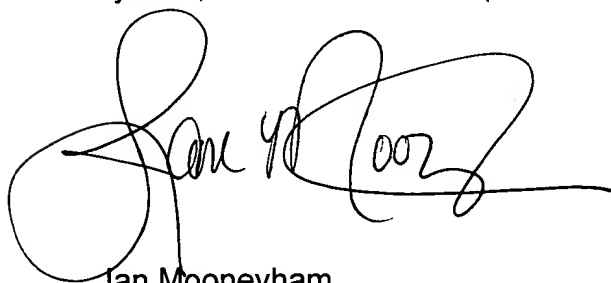
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a large, stylized loop at the end.

Jan Mooneyham  
Patent Examiner  
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